

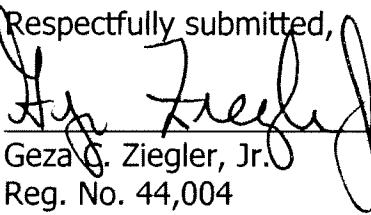
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s): Veijo Vanttinен CONF. NO. 7249
SERIAL NO.: 09/771,052 ART UNIT: 2617
FILING DATE: 1/26/2001 EXAMINER: Mehrpour,
Naghmeh
TITLE: LOCATION OF SUBSCRIBER TERMINAL IN PACKET-
SWITCHED RADIO SYSTEM
ATTORNEY
DOCKET NO.: 324-010115-US (PAR)

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Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST TO REINSTATE APPEAL

This is in response to the Office Action mailed April 9, 2008 in regard to the above-identified patent application. A prior notice of appeal and Pre-Appeal Brief Request for Review were filed on 30 April 2007. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed on 7 September 2007 (the "Decision"). No additional fees are due.

Respectfully submitted,

Geza S. Ziegler, Jr.
Reg. No. 44,004

9 July 2008
Date

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

This is in response to the Office Action mailed April 9, 2008 in regard to the above-identified patent application and is accompanied by a Request to Reinstate the Appeal in this application. A prior notice of appeal and Pre-Appeal Brief Request for Review were filed on 30 April 2007. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed on 7 September 2007 (the "Decision"). No additional fees are due.

It is respectfully noted that since the Decision, the Examiner has continued to issue Office Actions replete with repeated mistakes, and the responses and arguments submitted by the Applicant continue to be ignored. Since the Decision, a total of three new Office Actions have been issued. Each one is repetitive of prior actions, including the noted errors and mistakes. The new actions include a Non-Final Action on 21 September 2007, a Final Action on 23 January 2008, and now, after a Request for

Reconsideration filed 7 March 2008, another Non-Final Action on 9 April 2008. The prosecution history in this application is now quite long.

It is noted that in the Action the Examiner once again raises issues that have been previously addressed in prior responses. Bull is once again re-asserted against the claims of this application with no explanation as to how Bull can properly be a prior art reference when its effective filing date is **AFTER** Applicant's earliest effective filing date. The reference Korpela is raised in a rejection under 35 USC §103(a). However, it has been well established by Applicant, **on more than one occasion**, that Korpela is commonly owned by Applicant and is disqualified as a prior art reference pursuant to 35 USC §103(c). Yet, these very same rejections continue to be asserted against the claims of this Application.

1. Claims 1, 3-16, 18 and 20-33 are not anticipated by Bull et al. ("Bull) (US Patent Pub. 2006/0003775) under 35 USC §102(e) because (a) Bull does not qualify as prior art; and (b) its disclosure does not teach and every feature recited by Applicant in the claims.

This is not the first time the Examiner has cited Bull in the rejection of Applicant's claims. In each response thereto, Applicant has pointed out the deficiencies with Bull, including its later filing date. This most recently occurred with respect to the response filed on 7 March 2008 (see also the response filed on April 7, 2006.) It would appear that the Examiner has chosen to ignore Applicant's comments and arguments in this regard. Careful reconsideration is solicited.

(a) Bull **does not qualify** as prior art for purposes of 35 USC §102(e) because the filing date of Bull is June 10, 2005, which is **AFTER** Applicant's filing date of January 26, 2001, with a claim of priority to Finnish Patent Application Number 20000149, dated **January 26, 2000**. The relevant rules explicitly state that a person shall be entitled to a patent unless "(e) the invention was described in - (1) an application for patent, published under **section 122(b)**, by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for

patent, except that an international application filed under the treaty defined in **section 351(a)** shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under **Article 21(2)** of such treaty in the English language." (MPEP §2131; 35 USC §102(e)).

In this case Bull is not an application for patent by another filed in the United States **before** the invention by the Applicant for patent. Bull is a "continuation-in-part" application of U.S. Patent No. 6,782, 264 filed on July 18, 2001, which is a "continuation-in-part" application of US Patent No. 6,317,604 filed on March 31, 2000, which is a "continuation-in-part" application of US Patent No. 6,184,829 filed on January 8, 1999. The only reference in this line of "continuation-in-part" patents and applications that precedes Applicant's filing date is US Patent 6,184,829 (the '829 Patent) filed on January 8, 1999. However, **as has been previously noted** (see the response filed on April 7, 2006), the '829 Patent does not disclose or suggest each element recited by Applicant in the claims. It is submitted that the subject matter relied upon by the Examiner in Bull is **not present in the earlier filed application** and thus is NOT entitled to the filing date of the earlier application. If the Examiner maintains that Applicant's claimed subject matter is present, the Examiner is respectfully solicited to point out precisely when and where such disclosure is present. To date, no such showing has been made. In the absence thereof, Bull does not qualify, and cannot be used, as a prior art reference against Applicant's claimed subject matter. Therefore, claims 1-16 and 18-33 are not, and cannot be anticipated by Bull.

Additionally, the subject matter disclosed by Bull does not explicitly **recite each and every element** recited by Applicant in the claims. Claim 1 recites that "a subscriber terminal comprises means for transmitting a request message or location service to the core network via the radio network." This is not disclosed or suggested by Bull. Bull, in paragraph [0029] referred to by the Examiner, discloses that wireless devices may be identified and located based on their presence in a defined geographic area. The location area is loaded and a list of IMSIs, MSISDNs and associated TMSIs that can

initiate a network transaction in the geographic area of interest. A network transaction for this feature may be defined as a call origination or termination, a SMS exchange, and a location update. There is no disclosure here related to a subscriber terminal comprising means for transmitting a request message for location service to the core network via the radio network as claimed by Applicant.

Claim 1 also recites that the "network part comprises means for performing at least one function required in the request message and means for transmitting a response message to the subscriber terminal via the radio network." This is not disclosed or suggested by Bull. Bull only discloses, in paragraph [0073] referred to by the Examiner, that user equipment can be defined as equipment such as a UMTS mobile device. A RNC handles protocol exchanges between interfaces and is responsible for centralized operation and maintenance of the entire radio network system. This is not what is recited by Applicant in the claim.

Claim 1 also recites that "packet-switched connections are used between the core network, the radio network and the subscriber terminal for transmitting the request message and the response message." This is not disclosed or suggested by Bull. It is noted that the examiner has not identified any particular portion of Bull that might disclose or suggest this particular feature. It is submitted that this feature does not exist in Bull. Thus, the claim cannot be anticipated.

The examiner states that paragraph [0028] of Bull discloses transmitting a request message for location service. This is not correct. Paragraph [0028] only states that a system can be configured to locate mobile devices in a network. Any Time Interrogation queries are submitted to the home location register. This can result in a call being placed to the wireless device by the network using supplementary services. There is no disclosure here or elsewhere of transmitting a request message for location services. Thus, since each and every element recited by Applicant in the claims is not found in Bull, Bull cannot and does not anticipate claims 1-16 and 18-33.

3. The Examiner states that "Claims 17 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bull et al. (US Patent Number 2006/0003775 A1) in view of

Korpela (US Patent Number 6,311,055)." (see page 8 of Office Action mailed 9 April 2008)

It is respectfully noted that this ground of rejection has been raised by the Examiner on more than one occasion. Applicant has repeatedly pointed out the errors related to this rejection and provided explicit reasoning as to why this basis of rejection is invalid. Yet, the Examiner continues to re-assert the very same rejection, replete with the very same errors.

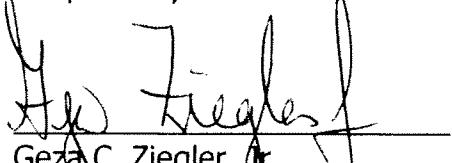
(a) The Examiner states that the claims are unpatentable over Bull in view of "Korpela (US Patent Number 6,311,055)." However, US Patent Number 6,311,055 **is not to** Korpela. Rather, US Patent Number 6,311,055 is to "Boltz". This error has been brought to the Examiner's attention on more than one occasion.

(b) "***Korpela***" ***is not prior art for purposes of 35 USC §103(a).*** In the body of the rejection, see page 8 of Office Action mailed 9 April 2008, the Examiner refers to Korpela. Korpela, as previously been identified, is US Patent Number 6,311,054. **It should be noted that this issue was previously addressed in at least two prior responses. One filed on April 6, 2005 and another filed on April 7, 2006.** In both of those responses, as well as a prior Request for Pre-Appeal Brief review, Applicant properly averred common ownership of Korpela pursuant to the requirements of 35 U.S.C 103(c). All of the prior responses are incorporated herein by reference. Therefore, Korpela is disqualified as a reference for purposes of U.S.C. §103(a) and this basis of rejection cannot stand. The continued assertion of at least this basis of rejection is nothing more than harassment of the Applicant and has led to unnecessary and burdensome prosecution of this application.

Review is respectfully solicited with an aim to providing some meaningful prosecution or the allowance of this application.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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